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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/798,391   | 03/12/2004  | Yuan-Chin Liu        | 3313-1130P          | 6032             |
| 2292   | 7590        | 10/17/2006           | EXAMINER            |                  |
| BIRCH STEWART KOLASCH & BIRCH<br>PO BOX 747<br>FALLS CHURCH, VA 22040-0747 |             |                      | JOERGER, KAITLIN S  |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3653                |                  |

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/798,391

Applicant(s)

LIU ET AL.

Examiner

Kaitlin S. Joerger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-13 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) 1,2 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claim 1 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: new claim 1 is not directed to a composite roller with a high friction surface and a low friction surface, as originally claimed, but is instead directed to a roller with only a high friction surface that rotates in the clockwise and then counterclockwise position during paper feeding.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1, 2, and 5 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-10, 12, 13, and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Burnham et al. (4,223,884).

Burnham et al. further teaches a pick mechanism comprising: a transmission gear, 74, connect to a power input shaft, 80; an idling gear, 76, engaged with the transmission gear having an axis coupled with the power input shaft through a first linkage bar, 82; a pickup gear, 72,

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engaged with the idling gear having an axis coupled with the axis of the idling gear through a second linkage bar, 70; and a pickup roller, 18, located on one side of the pickup gear coupling on a pivot shaft with the pickup gear in a coaxial manner; an outer frame, 64, fastened to an inner side of a paper tray frame, see column 4, lines 5+ and figure 4; and wherein the transmission gear is driven by the power input shaft to transfer driving power through the idling gear and the pickup gear, the pickup roller rotating in the direction of paper feeding to move a top sheet of paper in the paper tray. The pickup roller has a surface which include a high friction surface and a low friction surface, column 2, line 67 through column 3, line 38, the low friction surface permitting the paper to slide through, and the high friction surface having a length which is determined by the distance between and initial position of the paper and the feed roller, column 4, line 48 through column 5, line 40. The high friction surface is made from a soft rubber, column 3, lines 1+. The low friction surface is a wheel, 22, made from a hard plastic to provide a smooth surface, column 3, lines 26+. The power input shaft provides rotational power in two directions; see directional arrows on figures 6 and 7. The linkage bars are formed in a plate shape. The outer frame is fastened to the inner side of the paper tray through a linkage block, 66. The outer frame has at least one retaining slot run through by the pivot shaft and the outer frame is run through by the power input shaft, see figure 4.

The Burnham et al. discloses the claimed invention except that the gears of Burnham et al. are not located on an inner side of the outer frame. It would have been obvious to one of ordinary skill in the art to place the gears on the inner side rather than on the outer side of the outer frame, since it has been held that rearranging parts of an invention involves only routine

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skill in the art and change the location of the gears would not affect the operation of the pick mechanism. *In re Japiske*, 86 USPQ 70.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burnham et al. (4, 223,884) in view of JP 5-286585.

Burnham et al. teaches all of the features of the claimed invention except that the paper tray has one side forming a slot run through by the pivot shaft, but the JP '685 patent does teach this feature, see figure 4.

It would have been obvious to one of ordinary skill in the art to extend the power input shaft through the sheet tray in order to stabilize the shaft so that the pick mechanism does not vibrate or shake while in use.

### ***Response to Arguments***

Applicant's arguments filed 3 August 2006 have been fully considered but they are not persuasive.

The applicant argues that the Burnham et al. reference does not teach an outer frame fastened to an inner side of the paper tray, however, the Burnham et al. references does in fact teach this. The outer frame, 64, is a support frame and is fastened to an inner side of the paper tray through linkage arm, 66, and bracket 96, see figure 4 and column 4, lines 5+.

Further, the applicant argues that the JP-286585 reference does not teach the limitation claimed in claim 11, specifically a paper tray where one side forming a slot run through by the

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power input shaft. Figure 4 of the JP '585 reference clearly shows a paper tray with holes, or slots, formed in the sides and the power input shaft, 4, that runs through the slots.

Therefore the Burnham et al. reference and the JP-286585 clearly teach all the claimed limitations of the applicant's invention, and claims 6-13 and 16-20 remain rejected.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaitlin S. Joerger whose telephone number is 571-272-6938. The examiner can normally be reached on Monday - Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ksj  
  
12 October 2006

  
PATRICK MACKEY  
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